

REMARKS

The Examiner has rejected claims 12-22 under 112, alleging that the addition of the limiting term “only” following “RF transmission” in claims 12, 14, 17, and 19 “is not supported by the original specification” and thereby comprises new matter. Applicant requests reconsideration for the reasons set forth below.

The use of the term “only” in the claims was added as limiting terminology in an effort to further distinguish the present claimed system from that set forth in Beard and Sedam et al.

The specification of the present invention teaches systems only utilizing one-way (i.e., mono-directional) communication in the form of updated transmissions of data from the vending machine(s) to a designated local receiving area for reception by the service vehicle. It would be apparent to one of ordinary skill in the art that embodiments of the system taught in the present invention only use one-way RF transmission because the system does not teach, disclose, suggest, or otherwise require any other means of RF transmission other than one-way RF transmission. The system as taught and claimed, with the transmitter at one end and the receiver at the other, is incapable of bi-directional communication such as that shown in Sedam et al. The use of the term “only” does not add new matter, as it is inherent in the description that the invention is taught utilizing “only” mono-directional RF transmission, in the manner set forth in the claims.

The specification clearly contemplates and teaches one-way transmissions of data via RF; see for example, page 7, lines 1-5 “.. The preferred embodiment of the machine contemplates one-way transmissions of data via RF.”

As indicated, the addition of “only” to the claims was made as a limiting term to distinguish the claimed invention from the cited prior art, as the cited prior art does not teach, contemplate, or suggest such a system, requiring a more complex and expensive bi-directional data flow via transceivers or the like, and the fact that embodiments of the system as taught in the specification of the present invention uses mono-directional RF transmission only is readily ascertainable to one of ordinary skill in the art, **even though the word “only” may not be specifically used.**

As stated in the case Brand v Thomas 25 CCPA 1053, 96 F2d 301 (1938):

“Where a patent application disclosed a device that had to inherently do certain thing, it necessarily disclosed that function or thing even though it said nothing concerning it.”

The specification of the present case clearly teaches embodiments employing only one-way RF transmission in its apparatus and method descriptions of the claimed embodiments (as detailed above), and therefore it is appropriate to use “only” as a limiting term in the claims to distinguish the claimed system from the prior art.

Thus, it is submitted that the inclusion of “only” in the claims does not comprise new matter, but rather represents a limiting term inherent in the described invention, to better differentiate the claimed invention from the prior art.

As indicated in our last Response:

“Unlike the cited references, the present system does not require the use of transceivers as depicted in the prior art references; indeed, the claims of the present case, as amended, specifically recite mono-directional RF transmission only from the vending machines to the reception area. Accordingly, the service vehicle receives a signal when it enters the reception area; unlike the prior systems, no initial transmission from the service vehicle is required to initiate transmission of the vending information. Unlike the prior art, the system of the present invention in effect saturates the reception area with repeated transmissions so that the service vehicle, upon entering the area or shortly thereafter, receives the transmission(s). No two way transmissions of data are therefore required.

Accordingly, the present system does not require costly equipment, and dispenses with

the problems of providing a clear channel path for two-way communications; rather, the present system is only concerned with a single RF communication path from the vending machine(s) to the service vehicle at the pre-designated receiving area.

This concept is new to the vending industry, and the inventors in the present case introduced a product embodying the claimed invention, sold under the trademark "BuzzBox", in October 2002."

The Examiner admitted in the last Office Action that evidence of commercial success is strong, and leading experts in the industry have attested in declarations as to the unobviousness of the system, as submitted in the last Response dated 09/29/2004. It is requested that the Examiner reconsider the arguments and affidavits presented in our last response, in light of the above comment and argument.

Regarding Sedam and Beard, it is requested that the Examiner reconsider the argument, declarations, and attachments distinguishing Sedam and Beard from the present invention as set forth in the previous Response, which includes the following:

"The Examiner asserts that Sedam teaches "a sales and cash monitoring system for identified vending machines..where data is received a predetermined intervals.. to provide for more efficient scheduling of routes.. and utilizing radio communications for transmitting/receiving data.."

However, like Beard, Sedam requires bi-lateral communication to function (Sedam via a telephonic connection at the vending area utilizing a modem, which is not comparable to the present system as claimed (see Col 2, lines 47-56). Once again, the present invention contemplates a one-way, repeated transmission to the reception area which is periodically refreshed with new data, which transmission is received by the service vehicle when it reaches the receiving area.

As taught in the specification of the present application and claimed in one or more of the claims above of the present invention, a transmitter is provided generally with each of the vending machines, each transmitter in a group of vending machines independently repeatedly transmitting vending data, with all of the transmitters adjusted (if necessary) to provide a common reception area where all of the transmissions may be received by the delivery vehicle.

Thus, a group of independently operating transmitters each with their own unique, repeated, periodically refreshed transmissions is provided to the reception area, which transmissions are received and consolidated to provide the vending data for re-stocking product and change in the machines. This is not taught, suggested, or contemplated, alone or in combination via the prior art cited by the Examiner.

The Examiner has also cited Howell in its rejection of Claim 22 in combination with Sedam and Beard. Claim 22 as amended likewise overcomes this rejection, for reasons stated above.

Further, the Affidavits attesting to Non-obviousness and commercial success provide “secondary indicia of non-obviousness”, further overcoming the cited prior art.

The present system fills a unique and new market niche created by the present system which previously did not exist, has been installed at locations nationwide with success and is made possible and practical due to current technological advances that did not exist in the past.”

In order for a claim to be obvious under the prior art under 103, there must have been some explicit or implicit suggestion or motivation in the prior art to combine, substitute or otherwise modify the prior art in a way to produce the claimed invention. The “differences between the subject matter to be patented and the prior art” must be such as to render the “subject matter as a whole” obvious. As earlier indicated, it is inappropriate to use hindsight guided by the applicants disclosure. In the present case, the Examiner admits the invention of applicant is novel, that the product under the invention has “strong evidence” of commercial success.

Under Brown & Williamson Tobacco Corp v. Phillip Morris, Inc 229 F3d 1120, 56 USPQ2d 1456 (fed Cir 2000), a showing of obviousness requires a motivation or suggestion to combine or modify prior art references, coupled with a reasonable expectation of success.

The initial burden is on the examiner to make a rebuttable prima facie case of obviousness based upon the prior art. In re Rinehart 531 F2d 1048, 189 USPQ 143 (CCPA 1976). The applicant for a patent has no burden to show proof of non-obviousness until a prima facie case has been made by the examiner. Neither Sedam, Beard, nor Howell show the claimed invention, nor has there a showing of motivation or suggestion of combination of these references to teach the invention as claimed in the present application, which contemplates a much different system, requiring different equipment and technique than the prior art.

The Examiner now cites Schwartzendruber '784 asserting that it teaches mono-directional transmission between a vending machine and a service station. However, this is not the case. The Examiner is referencing Column 5 of '784 in support, but no where in said disclosure is there mention or suggestion of mono-directional data transmission. Rather, the cited language references modem communication over telephone lines, which by its very nature is bi-directional.

It is well known that a telephone system by its very nature is two-way voice/data conduit, and a modem working across a telephone line acts as both a sender and receiver of data, even when a certain data component might appear to be a "one way" transfer. A better analogy for a modem to modem data transfer over a telephone line is that of a transceiver to a transceiver, as two way communication is required to initiate, monitor, and complete data flow.

A modem initiates a call by first listening for a dial tone (in effect acting as a receiver), dialing the number (acting as a transmitter of sorts), the receiving modem communicates (like a transmitter-receiver, or transceiver) with a sending modem (acting like a transceiver) a handshake to discern speed and protocol prior to data transfer, then the data transfer occurs, with the receiving modem typically initiating periodic signals indicating the data has been received, to insure accuracy and completeness in the data transfer, then the call is terminated.

Attached please find (Exhibit "A") the reference work under "modem" from the Britannica 2003 Deluxe Edition CDROM Encyclopedia, which details modems, stating in part:

"Modems operate in part by communicating with each other, and to do this they must follow matching protocols, or operating standards.."

"Among other functions, these standards establish the signalling by which modems initiate and terminate communication, establish compatible modulation and encoding schemes, and arrive at identical transmission speeds".

Based upon the above, one concludes that telephone lines and modem communication over same is bi-directional in nature; put another way, even when certain data might seem to be flowing

in one direction, the conduit for transmitting that data requires bi-directional communications, and a telephone line is a bi-directional conduit of data/voice. Thus, the data transmission in '784 cannot be mono-directional only. Further, one can only conclude that '784 does not teach, suggest, anticipate, or otherwise contemplate the mono-directional data transfer of the present claimed invention.

In comparison to '784, the mono-directional RF communication of the claims of the present invention is truly one way. In the present invention, the transmitter transmits an updated string of information to a reception area for reception via a receiver on a service vehicle, when it enters the reception area. There is no handshake, protocol communication, dial tone, or other form of bi-directional communication in the system of the claims of the present application as would be required under a modem communication under Schwartzendruber.

In fact, in the system described and claimed in the present invention, the transmitter cannot discern if the transmitted data to the reception area has been received, as the receiver at the reception area has no way to communicate with the transmitter, and the transmitter would have no way to receive such a communication. Thus, the assertion that '784 contemplates the mono-directional RF is without basis, and reconsideration is therefore requested.

Claim 22 has been amended so that the limiting term "consisting of" is associated with the step "d", limiting the method of communication of the method to mono-directional RF transmission only in the method as claimed.

Neither Sedam, Beard, Schwartzendruber, alone or in combination, teach, suggest, or otherwise contemplate the method of claim 22, as the references could not or would not be physically combined in an operative fashion or to produce the desired result by a person of ordinary skill

without the use of the teachings of the present applicant¹, namely:

The method of servicing a vending machine, comprising the steps of:

- a) receiving data from a vending machine, providing received data;
- b) compiling said data to discern activity, providing filtered received data;
- c) preparing said filtered received data, providing a transmission string;
- d) communicating said transmission string to a reception area consisting of the step of transmitting, utilizing mono-directional RF transmission, said transmission string to a reception area in the vicinity of said vending machine;
- e) repeating steps a-d, while
- f) positioning a service vehicle within said reception area;
- g) receiving said transmission;
- h) utilizing data from said transmission to pull inventory and money change ~~fm~~
said service vehicle for servicing said vending machine, providing pulled inventory;
- i) conveying said pulled inventory to said vending machine;
- j) stocking said vending machine
- k) resetting said vending machine, resetting said filtered received data.

The applicant has provided declarations of non-obvious by credible experts in the industry, and the prior art has clearly failed to teach or anticipate the combination of the claims as set forth in the present invention, for reasons discussed above.

The Federal Circuit has made it very clear that secondary considerations must be considered when they are present, and are given equal weight to the primary consideration. WL Gore & Assoc v. Garlock, Inc., 721 F2d 1540, 1555, 220 USPQ 303, 314 (Fed Cir 1983) cert denied 469 US 851 (1984). Not only has there been presented declarations of non-obviousness from experts, but

¹. In re lintner 458 F2d 1013, 173 USPQ 560, 562 (CCPA 1972), In re Regal, 526, F2d 1399, 188 USPQ 136 (CCPA 1975); In Re Jansson, 609 F2d 996, 203 USPQ 976 (CCPA 1979).

there has been a clear showing of commercial success, and detailed declarations establishing the nexus between the commercial success and the invention, which must be given serious consideration. Demaco Corp v F Von Langsdorff Licensing Ltd 851 F2d at 1392, 7 USPQ2 at 126 (Fed Cir 1988), cert den 488 US 956 (1988).

These declarations cannot be ignored, but must be overcome by the Examiner with clearly relevant prior art teachings which on their face anticipate the claimed invention, with a 1) motivation to combine; and an 2) expectation of success², neither of which has been shown with the references cited. Accordingly, the claims are deserving of patent protection, and same is respectfully requested.

To repeat, the claims of the present application set forth a system which has not been taught, contemplated, suggested, alone or in combination, by the cited prior art, for reasons set forth above.

Thus, on reconsideration, it is respectfully submitted that the present claims should be allowed as being patentable under 35 U.S.C. 103.

If additional issues remain, and the Examiner is of the opinion that same could be resolved by telephone amendment, the undersigned respectfully requests same at (985) 845-0000.

Respectfully submitted,



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²Brown & Williamson Tobacco Corp v. Phillip Morris, Inc. 229 F3d 1120, 56 USPQ2d 1456 (Fed Cir 2000).



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CERTIFICATE OF MAILING

I HEREBY CERTIFY that the present document was deposited in the US Mail, First Class, postage prepaid and properly addressed to the Commissioner of Patents, US Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450, this 1st day of April, 2005.



Joseph T. Regard (PTO Reg 34,907, Cust 27,988)